

REMARKS

The Non-Final Office Action mailed October 4, 2010, has been received and reviewed. Claims 2, 5-7, 9, 10, 15, 16, 21 and 25-29 are pending in the subject application. All claims stand rejected. Each of claims 9 and 15 has been amended as herein above set forth. Care has been taken to introduce no new subject matter. Reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks.

I. Claim Objections

Claims 5 and 6 have been objected to as being of improper dependent form for ostensibly failing to further limit the subject matter of a previous claim. More particularly, it is stated that “[w]ith regards to claim 5, the parent claim already requires storing said annotation and storing the static image of the first active content associated with the annotation. With regards to claim 6, the parent claim already requires storing said annotation and the link to said active content.”¹

Applicants respectfully submit that claims 5 and 6 recite “a storage,” which is not recited in the parent claim 29. Support for “a storage” is found in FIGS. 1, 7, and 8, and paragraphs [52], [53], [54], [57], and FIG.s 1, 7 and 18 of the specification. Although claim 29 recites “a processor for storing,” it does not not recite “a storage.” Thus, claims 5 and 6 further limit the subject matter of claim 29, and are therefore in proper dependent form.

¹ *Office Action of 10/4/10*, p. 2.

II. Allowable Subject Matter

Applicants would like to thank the Examiner for the indication of allowable subject matter in Claim 21.

III. Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in Graham v. John Deere counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations.² To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in Graham and to provide some reason, suggestion, or motivation, found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention.³ Recently, the Supreme Court elaborated, at pages 13-14 of the *KSR* opinion, that “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in

² *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

³ *See, Application of Bergel*, 292 F. 2d 955, 956-957 (1961).

order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].”⁴

B. Obviousness rejection based upon U.S. Publication No. 2002/0049787 to Keely et al. in view of “Hypertext Interaction Revisited” to Golovchinsky et al.

Claims 9, 10, 15, 16 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0049787 to Keely et al. (hereinafter “Keely”) in view of “Hypertext Interaction Revisited”, AMC, May 30, 2000, ppgs. 171-179 to Golovchinsky et al. (hereinafter “Golovchinsky 1”).

1. Claim 9

- a. Amended claim 9 is not obvious at least because the references do not teach the claimed feature of “receiving a first display region that is an extracted portion of a first document, wherein the first display region is visibly designated by a first resizable bounding box within the first document, and wherein the first display region includes an image of an annotation and related content encompassed by the first resizable bounding box within the first document; receiving a second display region that is an extracted portion of a second document, wherein the second display region is visibly designated by a second resizable bounding box within the second document, and wherein the second display region includes an image of an annotation and related content encompassed by the second resizable bounding box within the second document.”

With regard to claim 9, it is stated in the outstanding Office Action that “Keely et al teaches a method of displaying clips comprising the steps of: receiving at least two display regions of one or more documents, each display region having a set of an annotation and related content, the at least two display regions being extracted from non-contiguous portions of the

⁴ *KSR v. Teleflex*, No. 04-1350, 127 S.Ct. 1727 (2007).

document or portions of different documents (Figure 13, paragraphs 0090-0098).”⁵ However, it is respectfully submitted that the cited portions of Keely merely describe various types of annotations that are displayed within a document. Further, the annotations are not within a received display region that is extracted from a document; rather, the annotations are simply displayed within the document. Nor does Keely teach that a display region is visibly designated in the document by a resizable bounding box. Additionally, the annotations described and illustrated in Fig. 13 of Keely are on a page *within a single document*. Applicants have been unable to find any portion of Keely that teaches or suggests “receiving a first display region that is an extracted portion of a first document, wherein the first display region is visibly designated by a first resizable bounding box within the first document, and wherein the first display region includes an image of an annotation and related content encompassed by the first resizable bounding box within the first document; receiving a second display region that is an extracted portion of a second document, wherein the second display region is visibly designated by a second resizable bounding box within the second document, and wherein the second display region includes an image of an annotation and related content encompassed by the second resizable bounding box within the second document,” as recited in amended claim 9.

- b. Claim 9 is not obvious at least because the references do not teach the claimed feature of “combining said first display region and said second display region to form a combination of the extracted portions of the first document and the second document.”**

With regard to claim 9, it is stated in the outstanding Office Action that Keely teaches “combining said at least two display regions to form a combination consisting of noncontiguous portions of the one or more documents; filtering said combination of said at least

⁵ *Office Action of 10/4/10*, p. 3.

two display regions (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, display anchor/region data is used to produce/combine clips comprising annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations);”⁶ However, Fig. 9 and the cited portions of Keely simply describe a list of annotations—not extracted display regions. Keely’s list of annotations is essentially no different than an index. Nor does Keely teach a combination of the extracted portions of different documents. Applicants have been unable to find any portion of Keely that teaches or suggests “combining said first display region and said second display region to form a combination of the extracted portions of the first document and the second document,” as recited in amended claim 9.

- c. Claim 9 is not obvious at least because the references do not teach the claimed feature of “rendering a resultant image having said clips, wherein one of said clips is a clip having the filtered combination of the extracted portions of the first document and the second document, and wherein said resultant image includes the images of the annotations and related content encompassed by said resizable first bounding box and said resizable second bounding box; and displaying the clips including the at least one clip having the filtered combination of the extracted portions of the first document and the second document.”**

It is stated in the outstanding Office Action that Golovchinsky 1 (and not Keely) teaches: “[W]herein each display region includes an image of an annotation and related content encompassed by that display region within the one or more documents (Figure 7: whereas, each annotation, is associated with related content. The annotation and related content encompassed by a region defined by a bounding box (page 175, column 2, whereas, the bounding box is expanded from the annotation to include context/related data)”⁷

⁶ Office Action of 10/4/10, p. 4.

⁷ Office Action of 10/4/10, p. 5.

However, Golovchinsky 1 does not teach that a clip includes portions that are extracted from two different documents. Golovchinsky 1 states that annotations come from different lexias, and lexias are pages within a document—not within different documents:

This change made it possible to combine strands from different lexias in a simple way that did not destroy the illusion of coherence.⁸

The novel now has many hypertextual qualities: It is polyvocal, non-linear, and participatory. Lexias (in this case pages) have been reassembled and recombined to make a new story.⁹

Applicants have been unable to find any portion of Golovchinsky 1 that teaches combining annotations from different documents.

It is further stated that Golovchinsky 1 (and not Keely) teaches “wherein said resultant image includes the images of the annotations and related content encompassed by said at least two display regions (page 174 (bottom of first column, top of second column): whereas, the a combination of display regions can be combined into a single clip as a theme). Additionally, as explained in page 175, the clippings created can be displayed into a resultant image that includes one or more annotations with their associated content (the clippings can be further filtered by a color).”¹⁰

However, Golovchinsky 1 does not teach resizable bounding boxes. Golovchinsky 1 describes two different versions of XLibris (“XLibris” and “XLibris/*Forward Anywhere*”), with each version using a different algorithm to calculate the size of the bounding box:

⁸ *Golovchinsky 1*, p. 176, column 2.

⁹ *Golovchinsky 1*, p. 171, column 1.

¹⁰ *Office Action of 10/4/10*, p. 5.

XLibris calculated the bounding box of each stroke, expanded it to the nearest line height (to create legible passages), and merged overlapping clippings. XLibris/Fonuard Anywhere extended this algorithm by clipping text at sentence boundaries rather than at line breaks.¹¹

Thus, Golovchinsky 1's bounding box is based on the stroke of an annotation, and is extended either to the end of a line or the end of a sentence, depending on the version. For a given annotation, the bounding box is calculated to be a certain size. There is no mention of resizing a bounding box for a given annotation.

As described above, Keely and Golovchinsky 1 fail to teach every feature of amended claim 9, either singly or in combination. Amended claim 9 is therefore believed to be in condition for allowance for at least the reasons given above.

2. Claims 10 and 25

Claims 10 and 25 depend directly from amended claim 9, thus including all the features thereof. Claims 10 and 25 are therefore believed to be in condition for allowance for at least the reasons given above with regard to amended claim 9.

3. Claim 15

- a. Amended claim 15 is not obvious at least because the references do not teach the claimed feature of "said filtering including performing handwriting recognition on annotations in order to search recognized text and determine whether annotations contain text that meets the specified filtering criteria."**

Applicants have been unable to find any portions of Keely or Golovchinsky 1 that teach "said filtering including performing handwriting recognition on annotations in order to search recognized text and determine whether annotations contain text that meets the specified

¹¹ *Golovchinsky 1*, p. 176, column 2.

filtering criteria,” as recited in amended claim 1. For at least that reason, amended claim 15 is therefore believed to be in condition for allowance.

4. Claim 16

Claim 16 depends directly from amended claim 15, thus including all the features thereof. Claim 16 is therefore believed to be in condition for allowance for at least the reasons given above with regard to amended claim 15.

C. Obviousness rejection based upon “A Marketing Based Interface for Collaborative Writing” to Hardock et al. in view of “Moving Markup: Repositioning Freeform Annotations to Golovchinsky et al.

Claims 2, 5, 6, 7 and 27-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “A Marketing Based Interface for Collaborative Writing”, AMC, November 5, 1993 to Hardock et al. (hereinafter “Hardock”) in view of “Moving Markup: Repositioning Freeform Annotations, October 27, 2002, ppgs. 21-29 to Golovchinsky et al. (hereinafter “Golovchinsky 2”).

1. Claims 27-29

- a. Claims 27-29 are not obvious in view of Hardock and Golovchinsky 2 at least because the references do not teach the claimed feature of “storing the annotation together with a static image of the active content as displayed in the current access session.”**

It is stated in the outstanding Office Action that Golovchinsky 2 (and not Hardock) “teaches storing the annotation together with a static image of the active content (Figure 1 and Figure 2: whereas, the document content/layout is changed, such that the annotations are repositioned by retrieving a static/original-bounding box, and adjusting to a new bounding box when accessing/referencing/linking to active/new-layout-data (page 25, bottom-

half of left column). However, the document referred to in Golovchinsky 2 is clearly not static; rather, the annotation has to be repositioned because the document has changed:

There are several reasons the layout of a document may change, as illustrated in Figure 1 and Figure 2. The user may change the font, the document may be viewed with a different aspect ratio or on a different device, it may be reformatted with a different style sheet, or the document itself may change. . . . The general case of an edited document involves two steps: detecting differences between document versions, and repositioning annotations on the new version.¹²

How annotations are transformed depends not only on the new layout of the document, but on the type of annotation as well. Annotations anchored to specific words or images are repositioned and resized relative to the new position and size of anchoring objects. Annotations anchored to passages are adjusted based on the new passage size.¹³

In both portions of Golovchinsky 2 cited in the Office Action, annotations are repositioned due to changes in the document. Further, Golovchinsky 2 states that its purpose is to accommodate dynamic document layout:

In this paper, we describe an implementation of a freeform annotation system that accommodates dynamic document layout.¹⁴

A changing document is not a static document. In the Office Action, with regard to the Hardock reference, interpreted a document to be active “since the document's detail/layout can change over time/not-static, as explained in page 265, figure 9: whereas, as shown, the layout and content of a paragraph can change due to edits.”¹⁵ Thus, according to the reasoning in the Office Action with regard to the Hardock reference, the document described in Golovchinsky

¹² Golovchinsky 2, p. 21, 2nd column.

¹³ Golovchinsky, p. 25, 1st column.

¹⁴ Golovchinsky, p. 21, abstract.

¹⁵ Office Action of 10/4/10, p. 9.

2 is active, not static, and thus Golovchinsky does not teach “storing the annotation together with a static image of the active content,” as recited in amended claim. Applicants have been unable to find any portion of Golovchinsky 2 that teaches or suggests “storing the annotation together with a static image of the active content as displayed in the current access session,” as recited in claim 27.

- b. Claims 27-29 are not obvious in view of Hardock and Golovchinsky 2 at least because the references do not teach the claimed feature of “rendering an image having clips, wherein at least one of said clips is a clip having the stored annotation and static image of the active content.”**

It is stated in the outstanding Office Action that Hardock teaches “[r]endering an image having clips, wherein at least one of said clips is a clip having the stored annotation and static image of the active content (Figure 4: whereas the clips has a shown with an annotation and a static image of the document).”¹⁶ However, Hancock does not store, render, or display clips; rather, Hardock stores and displays an entire document that has been annotated:

In this mode, MATE displays two views of the document (Figure 4). The left view shows the marked up document received from the collaborators, with each reviewer's annotations appearing in a different color. Additional marks can be made, but the underlying text does not change, similar to annotation mode. The right view shows the current version of the document.¹⁷

Applicants have been unable to find any portion of Hardock that teaches or suggests “rendering an image having clips, wherein at least one of said clips is a clip having the stored annotation and static image of the active content,” as recited in amended claim 1.

- c. Claims 27-29 are not obvious in view of Hardock and Golovchinsky 2 at least because the references do not teach the claimed feature of “storing a link to**

¹⁶ *Office Action of 10/4/10*, p. 10.

¹⁷ *Hardock*, p. 260, 2nd column.

the active content that was displayed in the user interface at the time of the current access session; . . . displaying the rendered clips, wherein selection of said annotation in said at least one clip accesses the active content via the stored link.”

It is stated in the Office Action that Hardock teaches “[s]toring a link to the active content that was displayed in the user interface at the time of the current access session (Figure 4: whereas, active content/current state of the annotated document is retrieved/linked, such that is the retrieved data is shown in a right window); . . . wherein selection of said annotation in said at least one clip accesses the active content via the stored link (Figure 4, page 260, right column: whereas, a user can point to an annotation in the left view, and the active document is linked for retrieval and displayed in a right window).”¹⁸

Applicants respectfully submit that Hardock does not use stored links to display a portion of a document that corresponds to an annotation. Instead, Hardock uses GoTo commands to display a portion of text. GoTo commands are well known in the art, and do not require or use a stored links. Hardock describes a “GoToText” command:

When GoTo Text is applied to a piece of text in one of the two views, the corresponding piece of text is **found** in the other view, and then the other view is aligned with the first view. The piece of text is also highlighted.¹⁹

Clearly, Hardock’s Goto Text command is a search function, not a link, because Hardock states “the corresponding piece of text is **found** in the other view.” If GoTo Text was based on a stored link, there would be no need to “find” the corresponding text, because its location would already be known, based on the link. Further, if Hardock’s GoTo Text command was based on stored links, it would require a stored link for every piece of text in a document, because the command

¹⁸ *Office Action of 10/4/10*, p. 10.

¹⁹ *Hardock*, p. 264, 2nd column (emphasis added).

is applied to text, not to annotations. And yet, Hardock says nothing about storing links, nor would it be practical to store links for every piece of text in a document.

Hardock teaches that the GoTo Text command is based on context, which implies a search function, and not on a link. Under the heading “Context Dependent Linked Navigation,”²⁰ Hardock states:

Whereas, the direct navigation mechanisms are based upon relative movements, the **context** dependent navigation allows the user to align the two views **based upon a specific piece of text** – context.²¹

Thus, Hardock’s GoTo Text command is not based on stored links.

With regard to the “GoTo Annotation” command, Hardock states:

GoTo Annotation is similar to GoTo Text, except that it is applied only to annotations. This means that GoTo Annotation can only be used in the annotation view. When GoTo Annotation is applied to a mark, the mark is interpreted, and if the interpretation is successful, the Edit view is aligned with the annotation view and the text affected by the command is highlighted.²²

Hardock’s GoTo Annotation command is clearly not based on a stored link, because execution of the command depends upon whether a mark is successfully interpreted. A stored link would not require that the mark be interpreted. And, as with the GoTo Text command, the GoTo Annotation command is based on aligning the text, not on a stored link:

[T]he Edit view is aligned with the annotation view and the text affected by the command is highlighted.²³

As described above, there is no teaching or suggestion of stored links. Thus, Hardock neither teaches nor suggests that either GoTo function employs stored links. Applicants have been

²⁰ Hardock, p. 264, 2nd column (emphasis added).

²¹ Hardock, p. 264, 2nd column (emphasis added).

²² Hardock, p. 264, 2nd column (emphasis added).

²³ Hardock, p. 264, 2nd column (emphasis added).

unable to find any portion of Hardock that teaches or suggests “storing a link to the active content that was displayed in the user interface at the time of the current access session; . . . displaying the rendered clips, wherein selection of said annotation in said at least one clip accesses the active content via the stored link,” as recited in claim 27.

As described above, Keely and Golovchinsky 2 fail to teach every feature of amended claim 9, either singly or in combination. Amended claim 9 is therefore believed to be in condition for allowance for at least the reasons given above.

2. Claims 2 and 5-7

Claims 2 and 5-7 depend directly from claim 29, thus including all the features thereof. Claims 2 and 5-7 are therefore believed to be in condition for allowance for at least the reasons given above with regard to claim 29.

CONCLUSION

For at least the reasons stated above, each of claims 2, 5-7, 9-10, 15-16, 21, and 25-29 is believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned—by telephone at 816-559-2697 or via email at mmsmith@shb.com (such communication via email is herein expressly granted)—to resolve the same prior to issuing a subsequent action.

It is believed that no fee is due in conjunction with the present communication. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket number MFCP.153622.

Respectfully submitted,

/Mollie M. Smith/

Mollie M. Smith
Reg. No. 65,739

TLB/MMS/tq
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-559-2697